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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,152	09/24/2003	Federico J. Benetti	GUID-008CON2	2852
36154 7590 09/24/2008 LAW OFFICE OF ALAN W. CANNON 942 MESA OAK COURT SUNNYVALE, CA 94086				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
09/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/670,152

**Applicant(s)**

BENETTI ET AL.

**Examiner**

Pedro Philogene

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-38 and 40-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-38 and 40-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/2/08 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckman et al. (5,984,867) in view of Chin (5,676,636).

With respect to the claims, Deckman et al disclose a surgical apparatus for accessing a beating heart, the apparatus comprising a main body (22,102) configured to rest against the frontal body of a patient; and a lifting arm (40) rotatably mounted to the main body, as set forth in column 4, lines 46-50, and adapted to (or capable to) engage and lift at least a portion of the ribs of the patient, relative to remainder of the patient's body below the rib cage, while the body remains resting against the frontal body of the patient, when the patient is positioned horizontally; as best seen in FIG.12; a retractor arm (30) mounted to the main body and adapted to engage and spread a portion of the

ribs with respect to the remainder of the ribs, in a direction different from a direction of the lifting, wherein the retractor arm comprises a hinge (60,80) to enhance positioning of a distal end of the retractor arm to engage the ribs; as set forth in column 4, lines 10-50, column 5, lines 33-67, column 6, lines 1-35; wherein the retractor arm is rotatably mounted to the body; as set forth in column 7, lines 53-67, the apparatus comprising two contact points, and wherein the lifting arm is mounted to the body at a location intermediate of the two contact points; (two contacts points at 34 and 102 and lifting arm mounted therebetween in FIG.6); three contacts points (at fig.6, the retractor 30, the foot plate 102, and the lifting arm 40), the retractor arm (30) mounted to the main body and adapted to engage and spread a portion of the ribs with respect to the remainder of the ribs, in direction different from a direction of the lifting; a first driving mechanism (74) for driving the lifting arm with respect to the body to perform lifting, and a second driving mechanism (130) for driving the retractor arm with respect to the body to perform the spreading; a beating heart stabilizer mounted on the body, as best seen in FIG.9, and as set forth in column 8, lines 57-67, column 9, lines 24-44, an organ or tissue positioner (234a) fixed to the body; as set forth in column 9, lines 29-30; a light mounted to the apparatus; as set forth in column 9, lines 59-65; a locking mechanism (82) to fix the position of the means (40) for vertically offsetting in a vertically offset configuration, wherein the vertically offsetting means is a retractor (40) having a lifting arm operatively attached to a retractor frame.

With respect to the method claims, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above, such as

making an incision, contacting tissue, contacting tissue on one side of the incision with first portion of a retractor (30), while contacting tissue on an opposite side of the incision with a second portion of the retractor (40); and moving the second portion of the retractor in direction substantially perpendicular to a horizontal orientation of the remainder of the retractor, thereby vertically offsetting at least a portion of the rib cage; as best seen in FIG.6. Said means for offsetting comprising means for engaging the lowermost edge of the lowest rib on at least one side of the incision; as best seen in FIGS.13, 14 of Chin.

With regard to the recitation that an element is "adapted to" or "configured to" it is noted that it has been held that the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1887).

It is noted that Beckman et al did not teach of a lifting arm rotatably mounted to the main body and adapted to engage a lowermost edge of the lowest rib, as claimed by applicant. However, in similar art, column 7, lines 37-67, FIGS.13, 14, Chin provides the evidences of the use of a lifting arm rotatably mounted to a main body and adapted to engage a lowermost edge of a lowest rib of a patient to impart a lifting force to the sternum and ribs via the retractor bars and maintain a lifting throughout the duration of the procedure.

Therefore, given the teaching of Chin, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deckman et al, as taught by Chin, to impart a lifting force to the sternum and ribs via the retractor bars and maintain a lifting throughout the duration of the procedure.

Claims 29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckman et al. (5,984,867) in view of chin (5,676,636) in view of Asrican (3,680,546).

With respect to the above claims, it is noted that the above combination of references did not teach of fiber optic light; as claimed by applicant. However, in a similar art, Asrican evidences the use of fiber optic light to serve to direct the direction of light in the chest cavity.

Therefore, given the teaching of Asrican, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deckman et al./chin, as taught by Asrican, to serve to direct the direction of light in the chest cavity.

### ***Response to Amendment***

Applicant's arguments filed 7/2/08 have been fully considered but they are not persuasive. First, applicant's remark with respect to the Terminal Disclaimer is noted. The Terminal Disclaimer has been approved and the rejection removed. Second, instead of column 4, lines 46-50, applicant's attention is directed to column 7, lines 53-67. As to the blades engaging the lowest rib of a patient, Chin discloses a blade that

engages lowermost rib from a lower surface or edge of the rib of a patient and lift it.

Therefore, the combination of Beckman et al and rib meets applicant claimed invention.

### ***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
September 22, 2008